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09/532,937	03/22/2000	Stefan Georg Hild	RSW9-99-132	9182

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07/30/2003

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EXAMINER

ENGLAND, DAVID E

ART UNIT

PAPER NUMBER

2143

DATE MAILED: 07/30/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/532,937

Applicant(s)

HILD ET AL.

Examiner

David E. England

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 May 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-36 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-36 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- ☐ Interview Summary (PTO-413) Paper No(s). _____.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____.

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DETAILED ACTION

1. Claims 1 – 36 are presented for examination.

Claim Objections

1. Claims 31, 33 and 35 are objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. The limitation in claim 31 that states, “customizing the requested document identified by the link element based on the inserted at least on of said plurality of requested client properties,” which is found in its parent claim of claim 1 which states, “inserting at least one of said plurality of requested client properties into a request so as to allow customization of the requested document identified by the link element based on the inserted at least one of said plurality of requested client properties.” This is further apparent in claim 33 and its parent claim 11 and claim 35 with its parent claim 21.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

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2. Claims 1, 2, 11, 12, 21, 22, 31, 33 and 35 are rejected under 35 U.S.C. 102(e) as being anticipated by Merriman et al. U.S. Patent No. 5948061 (hereinafter Merriman).
3. Referencing claim 1, Merriman teaches in a networked environment, a method for designating client properties comprising:
4. receiving a link element associated with a server, that link element including a plurality of requested client properties, (e.g. col. 3, line 24 – col. 4, line 11 & col. 5, line 33 – col. 7, line 43);
5. selecting said link element to request a document identified by the link element to be transmitted to a client, (e.g. col. 3, line 24 – col. 4, line 11 & col. 5, line 33 – col. 7, line 43);
6. inserting at least one of said plurality of requested client properties into a request so as to allow customization of the requested document identified by the link element based on the inserted at least one of said plurality of requested client properties, (e.g. col. 3, line 24 – col. 4, line 11 & col. 5, line 33 – col. 7, line 43).
7. Referencing claim 2, Merriman teaches said plurality of requested client properties is contained within an attribute of said link element, (e.g. col. 3, line 24 – col. 4, line 11).
8. Claims 11, 12, 21, 22, 31, 33 and 35 are rejected for similar reasons as stated above.

Claim Rejections - 35 USC § 103

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claims 3, 13, 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over

Merriman et al. U.S. Patent No. 5948061.

11. As per claim 3, Merriman does not specifically teach wherein said attribute is a

PROFILEATTRS attribute.

12. Official Notice is taken that it was a common practice to have an attribute similar to

PROFILEATTRS at the time the instant invention was made.

13. It would have been obvious to one having ordinary skill in the computer art at the time of the invention was made to modify the method/system disclosed by Merriman because if a link is selected from a web page and the link gathers information from the user, there is a program tag that give that link the ability to carry out that function. Furthermore, disclosed by the applicant on page 14, lines 9 – 13 states,

14. "Though Figures 5A, 5B, and 5C show links annotated in a particular way, it is understood that alternative embodiments of this invention may employ a variety of different formats, including different attribute names (other than PROFILEATTRS), different syntax for listing requested properties, or different syntax for designated wild

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cards or mandatory attributes, it is understood that these alternative embodiments do not take away from the inventive constructs herein.”

15. Claims 13 and 23 are rejected for similar reasons as stated above.

16. Claims 4, 5, 14, 15, 24, 25, 32, 34 and 36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Merriman (5948061) in view of Gershman et al. (6401085) (hereinafter Gershman).

17. As per claim 4, Merriman does not specifically teach each one of said requested client properties comprises a category, a separator, and a property name. Gershman teaches each one of said requested client properties comprises a category, a separator, and a property name, (e.g. cols. 16 – 17). It would have been obvious to one skilled in the art at the time the invention was made to combine Gershman with Merriman because if the program language requires the programmer to apply this type of context for the program to run properly, it would be in the best interest to use this syntax so that the invention would work.

18. As per claim 5, Merriman does not specifically teach said plurality of requested client properties includes at least one property that is a wild card. Gershman teaches said plurality of requested client properties includes at least one property that is a wild card, (e.g. col. 21 – 22). It would have been obvious to one skilled in the art at the time the

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invention was made to combine Gershman with Merriman because it would be more efficient for a user to utilize this very common utility as a wild card, (i.e. *.doc, hyper\$ism, ect.), to broaden a field of search.

19. As per claim 34, Merriman does not specifically teach at least one of the plurality of requested client properties is associated with hardware characteristics of the client. Gershman teaches at least one of the plurality of requested client properties is associated with hardware characteristics of the client, (e.g. col. 58, lines 21 – 29). It would have been obvious to one skilled in the art at the time the invention was made to combine Gershman with Merriman because having hardware as at least one requested client property could aid in the transmission, storage and compatibility of the system that is transmitting the client information. For example, if a client wanted to download information after accessing a link and the user didn't have a fast enough transmission median, the server from which the download is coming from would know this from the transmitted hardware information that was requested from the client, therefore the server could make the necessary changes to make sure that the download transmits successfully without error or deny the client altogether.

20. Claims 14, 15, 24, 25, 34 and 36 are rejected for similar reasons as stated above.

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21. Claims 6, 7, 10, 16, 17, 20, 26, 27, 30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Merriman (5948061) in view of Heidorn et al. (6098081) (hereinafter Heidorn).
22. As per claim 6, Merriman does not specifically teach said plurality of requested client properties includes at least one property that is designated as a mandatory property. Heidorn teaches said plurality of requested client properties includes at least one property that is designated as a mandatory property, (e.g. col. 7, lines 18 – 27). It would have been obvious to one skilled in the art at the time the invention was made to combine Heidorn with Merriman because it would be more efficient for a system to have at least one property that the system could use to identify a user. If there is no property for a user then the user does not exist in the system.
23. As per claim 7, Merriman does not specifically teach said step of inserting comprises the steps of:
24. selecting each one property from said plurality of requested client properties; and
25. determining whether said each one property is available to be transmitted. Heidorn teaches said step of:
26. inserting comprises the steps of selecting each one property from said plurality of requested client properties, (e.g. col. 3, line 56 – col. 4, line 34); and
27. determining whether said each one property is available to be transmitted, (e.g. col. 3, line 56 – col. 4, line 34). It would have been obvious to one skilled in the art at the time

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the invention was made to combine Heidorn with Merriman because it would be more efficient if the system error check to see if the system or user had specific property data to transmit to the system. If the system didn't have this function it could cause error in the system and build a property list or table that has incorrect property information about a user making the system flawed.

28. As per claim 10, Merriman does not specifically teach the step of terminating the request if a mandatory property is not available to be transmitted. Heidorn teaches the step of terminating the request if a mandatory property is not available to be transmitted, (e.g. col. 3, line 56 – col. 4, line 34). It would have been obvious to one skilled in the art at the time the invention was made to combine Heidorn with Merriman because if the user didn't have the information that is mandatory for the system to function then the system would not be able to execute its functions therefore, making the inventions function useless.

29. Claims 16, 17, 20, 26, 27, 30 are rejected for similar reasons as stated above.

30. Claims 8, 9, 18, 19, 28, 29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Merriman (5948061) in view of Heidorn (6098081) in further view of Gershman (6401085).

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31. As per claim 8, Merriman and Heidorn do not specifically teach said step of selecting further comprises expanding a wildcard property. Gershman teaches said step of selecting further comprises expanding a wildcard property, (e.g. cols. 21 – 22). It would have been obvious to one skilled in the art at the time the invention was made to combine Gershman with Merriman and Heidorn because it would be more efficient for the system to be able to utilize the function of a wild card, (i.e. the ability of have a symbol to stand for different files and/or letters).
32. As per claim 9, Merriman does not specifically teach said step of determining further comprises prompting a user whether to transmit said each one property. Heidorn teaches said step of determining further comprises prompting to transmit said each one property, (e.g. col. 3, line 56 – col. 4, line 34 & col. 7, lines 18 – 27), but does not teach said step of determining further comprises prompting a user whether to transmit. Gershman teaches said step of determining further comprises prompting a user whether to transmit, (e.g. col. 3, lines 14 – 29 & col. 43, line 45 – col. 44, line 14). It would have been obvious to one skilled in the art at the time the invention was made to combine Gershman and Heidorn with Merriman because make a system have more versatility for a user that would want to utilize the system but would not want to divulge certain information that would be considered private and/or vital to a user, (i.e. cookies that might have credit card information, social security number). Having this option would make a user more likely to utilize the invention for it security reasons.

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33. Claims 18, 19, 28, 29 are rejected for similar reasons as stated above.

Response to Arguments

34. Applicant's arguments filed 05/14/2003 have been fully considered but they are not persuasive.

35. In the remarks, Applicant argued in substance that states that nothing Merriman discloses or suggests at least these recitations of claims 1, 11 and 21, and that Applicants respectfully submit that Amended Independent claims 1, 11 and 21 are not anticipated by the cited reference.

36. As to part 1, Examiner would like to draw the attention of the Applicant to the cited reference with column and lines of the action stated above and that was stated in the previous action filed 2/12/2003 and further in column 5, line 33 – column 7, line 43 of Merriman (5948061). In this section the Applicant will find that Merriman does teach receiving a link element associated with a server, that link element including a plurality of requested client properties;

37. selecting said link element to request a document identified by the link element to be transmitted to a client;

38. inserting at least one of said plurality of requested client properties into a request so as to allow customization of the requested document identified by the link element based on the inserted at least one of said plurality of requested client properties. As is very

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apparent, the first two sections of claim 1 is a common way for users to select a web site though a hyperlink. The third part of claim 1 can be found in Merriman, where in the reference Merriman teaches "The preferred embodiment also includes determining which advertising object should be selected if two or more advertising objects have criteria matching the user selection from the matched advertisements by determining how often the particular user has been exposed to the given advertisement," as for one example. In this passage the server where the advertisements are held save information from the user as the user selects the advertisement hyperlink, and in doing determines the type of advertisement the user will receive from the accumulated information the advertisement server has on the user. If the Applicant reviews the sections disclosed that Merriman teaches, the Applicant will have a better understanding of how exactly the invention relates to the Applicant's limitations.

39. In the remarks, Applicant argued in substance that as discussed above with respect to claims 1, 11 and 21, nothing in the cited references discloses or suggests receiving a link element including a plurality of requested client properties, thus, it follows that nothing in the cited references discloses or suggests that the plurality of requested client properties is a wild card as recited in Claims 4, 14 and 24.

40. As to part 2, Examiner would like to draw the Applicant's attention to the information disclosed in the part 1 of the remarks as to the argument presented in part 2. Furthermore, there are no remarks that specifically state why, reasons or lack of functionality in the

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references that were used to reject claims 4, 14 and 24, to support specifically why the stated references do not disclose the limitations stated in claims 4, 14 and 24, therefore, the examiner would like to draw the attention of the Applicant to the rejection stated above as it stands to reject claims 4, 14 and 24.

41. In the remarks, Applicant argued in substance that nothing in the cited references discloses or suggests that at least one of the plurality of client properties is a wild car, thus it also follow that none of the sited references discloses or suggests expanding the wild card property as recited in claims 8, 18 and 28.

42. As to part 3, Examiner would like to draw the Applicant's attention to the information disclosed in the part 1 of the remarks as to the argument presented in part 3. Furthermore, there are no remarks that specifically state why, reasons or lack of functionality in the references that were used to reject claims 8, 18 and 28, to support specifically why the stated references do not disclose the limitations stated in claims 8, 18 and 28, therefore, the examiner would like to draw the attention of the Applicant to the rejection stated above as it stands to reject claims 8, 18 and 28.

43. In the remarks, Applicant argued in substance that as discussed above with respect to claims 1, 11 and 21, nothing in the cited references discloses or suggests receiving a link element including a plurality of requested client properties, thus it follows that nothing in

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the cited references discloses or suggests that at least one of the plurality of requested client properties is a designated as a mandatory property as recited in claims 6, 16 and 26.

44. As to part 4, Examiner would like to draw the Applicant's attention to the information disclosed in the part 1 of the remarks as to the argument presented in part 4. Furthermore, there are no remarks that specifically state why, reasons or lack of functionality in the references that were used to reject claims 6, 16 and 26, to support specifically why the stated references do not disclose the limitations stated in claims 6, 16 and 26, therefore, the examiner would like to draw the attention of the Applicant to the rejection stated above as it stands to reject claims 6, 16 and 26.

45. In the remarks, Applicant argued in substance that nothing in the cited references discloses or suggests that a least one of the plurality of client properties is designated as a mandatory property, thus, it also follows that none of the cited references discloses or suggests terminating the request based on the mandatory property not being available to be transmitted as recited in claims 10, 20 and 30.

46. As to part 5, Examiner would like to draw the Applicant's attention to the information disclosed in the part 1 of the remarks as to the argument presented in part 5. Furthermore, there are no remarks that specifically state why, reasons or lack of functionality in the references that were used to reject claims 10, 20 and 30, to support specifically why the stated references do not disclose the limitations stated in claims 10, 20 and 30, therefore,

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the examiner would like to draw the attention of the Applicant to the rejection stated above as it stands to reject claims 10, 20 and 30.

47. In the remarks, Applicant argued in substance that nothing in the cited references discloses or suggests that a link element including a plurality of requested client properties or inserting at least one of the requested client properties into a request. Thus, it follows that nothing in the cited references discloses or suggests details with respect to inserting the at least one requested client properties into the request recited in claims 7, 17 and 27.

48. As to part 6, Examiner would like to draw the Applicant's attention to the information disclosed in the part 1 of the remarks as to the argument presented in part 6. Furthermore, there are no remarks that specifically state why, reasons or lack of functionality in the references that were used to reject claims 7, 17 and 27, to support specifically why the stated references do not disclose the limitations stated in claims 7, 17 and 27, therefore, the examiner would like to draw the attention of the Applicant to the rejection stated above as it stands to reject claims 7, 17 and 27.

49. In the remarks, Applicant argued in substance that the cited portions of Heidorn and Gershman do not discloses or suggests "prompting a user whether to transmit the selected ones of the plurality of requested client properties" as recited in amended claims 9, 19 and 29.

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50. As to part 7, Examiner would like to draw the Applicant's attention to the rejection stated above for claims 9, 19 and 29 and not only does the combination of Merriman, Heidorn and Gershman teach the limitations described above, Gershman teaches prompting a user whether to transmit the selected ones of the plurality of requested client properties in column 3, lines 14 – 29 and further teaches the limitation in column 43, line 45 – column 44, line 14.

51. In the remarks, Applicant argued in substance that none of the cited references either alone or in combination disclose or suggest the recitations of at least the dependent claims set out above. Furthermore, there is no motivation or suggestion to combine the cited references as suggested in the Office Action. As recently affirmed by the Court of Appeals for the Federal Circuit in *In re Sang-su Lee*, a factual question of motivation is material to patentability, and cannot be resolved on subjective belief and unknown authority. It is improper, in determining whether a person of ordinary skill would have been led to this combination of references, simply to "[use] that which the inventor taught against its teaches" *W.L. Gore v. Garlock, Inc.*, 721 F.2d 1540, 1553, 220 U.S.P.Q. 303, 312-13 (Fed. Cir. 1983). In other words, the Office Action does not point to any specific portion of the cited references that would induce one of skill in the art to combine the cited references as suggested in the Office Action.

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52. As to part 8, In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

Conclusion

3. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

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
Any inquiry concerning this communication or earlier communications from the examiner should be directed to David E. England whose telephone number is 703-305-5333.

The examiner can normally be reached on Mon-Thur, 7:00-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David A. Wiley can be reached on 703-308-5221. The fax phone numbers for the organization where this application or proceeding is assigned are none for regular communications and none for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is none.

David E. England
Examiner
Art Unit 2143

De 
July 26, 2003


DAVID WILEY
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2100